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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/726,613	10/07/96	MORI	J 50184

ROBERT L GOLDBERG
PO BOX 556
MARLBOROUGH MA 01752

IM51/0406

EXAMINER

CHU, J

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 04/06/99

Please find below and/or attached an Office communication concerning this application or
proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/726,613

Applicant(s)

Mori et al

Examiner

chu

Group Art Unit

1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/18/98.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4-15, 18-20 and 22-27 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 4-15, 18 and 19 is/are allowed.
- ☒ Claim(s) 20, 22, 23, 25 and 26 is/are rejected.
- ☒ Claim(s) 24 + 27 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Upon reviewing the potential interference, it was noted that certain claims may not be allowable. Accordingly the current office action rejects and addresses those issues.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 22, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mertens et al.

The claimed invention is drawn an article of manufacture having coated thereon a photoresist composition comprising a resin binder, a photoactive component and a polymeric dye that contains one or more polycyclic chromophores, said dye compound being a polymer wherein the polymer has a weight average molecular weight of at least about 5,000.

Mertens et al discloses a photosensitive composition comprising a binder resin (col. 26, lines 46-56), a photoactive compound (col. 16, lines 46-58) and sensitizers which have poly cyclic chromophores (col. 22)

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Mertens et al lacks the use of a polycyclic chromophore used in an example.

It would have been *prima facie* obvious to one of ordinary skill in the art of photochromic articles to use an addition sensitizer as disclosed in column 16, line 67 - column 26, line 39 and reasonably expect same or similar results as disclosed in the examples.

Motivation is based on the desire to have additional sensitizers to increase the spectral range of the composition.

2. Claims 24 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Claims 1, 4-15, 18 and 19 remain allowable over the prior art of record.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Laridon et al '752 and '245 disclose photochromic compositions having polymeric photochromic dyes.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

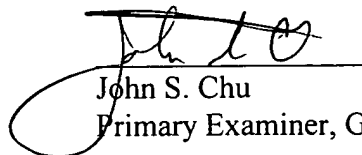
The fax phone number for this Group is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



John S. Chu
Primary Examiner, Group 1700

J.Chu
March 31, 1999